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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,560	05/23/2001	Mimi C. Dong	10010208-1	9404

7590 10/20/2005

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Intellectual Property Administration
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EXAMINER

LE, BRIAN Q

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,560

Applicant(s)

DONG, MIMI C.

Examiner

Brian Q. Le

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

PROSECUTION REOPENED

1. In view of the Appeal Brief filed on 07/21/2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-9, and 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ranalli et al. U.S Patent No. 6,539,077.

Regarding claim 1, Ranalli discloses a device (system) (abstract) comprising: a connection to a network (Internet-enabled communication) (abstract); and a network address derived from a fingerprint (Ranalli discloses a unique identifier which can be a fingerprint. Network address/Internet address is then provided/derived/generated to associate with the unique identifier of the fingerprint) (column 2, lines 25-50 and column 6, lines 10-25).

Referring to claim 2, Ranalli further discloses the device wherein the network is the Internet and network address is an Internet address (column 2, lines 30-35).

For claim 4, Ranalli teaches the device further comprising a fingerprint file storing the fingerprint (database to store unique identifier from fingerprint) (column 2, lines 25-30 and column 12, lines 35-38).

Also to claim 5, as explained in claim 4, Ranalli further teaches the device further comprising a fingerprint file storing the network address derived from the fingerprint (column 2, lines 25-30 and column 12, lines 35-38).

For claim 6, please refer back to claim for the teaching and explanation.

For claim 7, Ranalli teaches the system wherein the network address is derived from a fingerprint of an authorized user (user who may be reached) (column 2, lines 25-50 and column 6, lines 10-25).

For claim 8, please refer back to claim 2 for the teaching and explanation.

Regarding claim 9, Ranalli teaches the system wherein the network address is an address of a global network (internet address is global address since every system globally can recognize it) (abstract).

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For claims 11-12, please refer back to claims 4-5 respectively for the teaching and explanation.

Referring to claim 13, Ranalli also discloses the system further comprising: a server coupled to the Internet; and at least one appliance coupled to the server (data network/network printer) (column 3 and FIG. 4).

Regarding 14, as well explained in claim 1, Ranalli also teaches a method, comprising: generating a network address derived from a fingerprint; and accessing a system over a network using the derived network address (column 2, lines 25-50 and column 6, lines 10-25).

For claim 15, Ranalli teaches the method further comprising obtaining a Fingerprint (column 6, lines 20).

For claim 16, please refer back to claims 4-5 for the teaching.

Referring to claim 17, please refer back to claim 1 for the teaching and explanation.

Regarding claim 18, please refer back to claim 13 for the teaching and explanation.

For claim 19, Ranalli further teaches the method, as set forth in claim 14, further comprising generating system authorization based on the fingerprint (system allow the accessibility base on unique identifier of the fingerprint) (column 2, lines 35-39).

4. Claims 1, 3, 6, 10, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoshino U.S. Patent No. 6,636,620.

Regarding claim 1, Hoshino teaches a device (personal identification system) comprising: connection to a network (computer or server); and network address derived from a user's fingerprint (the accessibility to computer which has a network address by authenticating fingerprints) (abstract).

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For claims 3 and 10, Hoshinot also teaches the device comprising fingerprint scanner (fingerprint sensor) (FIG. 2, element 46).

For claims 6 and 14, please refer back to the teaching and explanation of claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranalli et al. U.S Patent No. 6,539,077.

Regarding claims 3 and 10, Ranalli teaches a scanner (column 11, lines 38-43) but does not explicitly teaches a fingerprint scanner though it does use input fingerprints. The Examiner takes Office Notice that it would have been obvious for one skilled in the art to obtain fingerprint using a fingerprint scanner to scan fingerprint indicia because this is the conventional way to input fingerprints and would be needed to properly use the invention.

CONCLUSION

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to a system connect to network and also derived from a user's fingerprint:

U.S. Pat. No. 6,636,973 to Novoa, teaches secure and dynamic biometrics-based token generation for access control and authentication.

U.S. Pat. No. 6,392,636 to Ferrari, teaches touchpad providing screen cursor/pointer movement control.

U.S. Pat. No. 6,175,640 to Wada, teaches fingerprint comparing apparatus.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 571-272-7695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BL
October 17, 2005

Superv
JOSEPH MANCUSO
PRIMARY EXAMINER